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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,420	12/20/2001	Todd A. Schwartz	884.619US1	2690
21186	7590	08/23/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			SHAH, AMEE A	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/027,420	SCHWARTZ ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Amee A. Shah	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 22 June 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-24 is/are pending in the application.
  - 4a) Of the above claim(s) 6, 7 and 12-24 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 and 8-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 December 2005 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

Claims 1-5 and 8-11 are pending in this action.

***Response to Appeal***

In view of the Appeal Brief filed on June 22, 2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

***Examiner Notes***

(1) The listing of the claims submitted in the Appeal Brief of June 22, 2006 and the claims filed December 1, 2005, describe claim 7 as being pending and rejected. The Remarks of

December 1, 2005, however, state that claim 7 is withdrawn (*see* page 8). The Examiner will abide by the Remarks and withdraw claim 7, as it was a dependency of previously withdrawn claim 6 and otherwise subject to rejection under 35 U.S.C. §112, second paragraph.

(2) Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-5 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kay et al., US 2002/0144275 A1 (hereafter referred to as “Kay”) in view of Cansler et al., US 6,725,257 (hereafter referred to as “Cansler”).**

Referring to claim 1. Kay discloses a digital content pricing apparatus, (see Abstract) comprising:

- a sales computer to calculate a final price (Fig. 1 and page 2, ¶0034 – note the computer is the billing system (160) that is capable of calculating a final price); and
- a memory capable of being communicatively coupled with the sales computer, including a plurality of digital content items (Fig. 1 and page 2, ¶¶0029-0032 and 0034 – note the memory is the server (130) which is capable of being coupled to the billing system), wherein each one of the plurality of digital content items is associated with a base price (Fig. 3 and page 3, ¶0045 – note the base price is the default price).

Kay discloses the memory storing a base price (i.e. the default price) and another price (i.e. a discount) wherein each of the plurality of digital content items is associated with a final price related to the base price and another price by a final pricing formula (Figs. 12C, 15 and 16 and pages 3-4, ¶¶0045-0052). However, Kay does not explicitly show wherein the memory includes at least one item configuration option associated with an option price, and wherein the other price associated with a final price to the digital content item by a pricing formula is the option price.

Cansler, in the same field of endeavor of electronic shopping, discloses a system for configuring a product using a server and computer network wherein the product has multiple configurations and the memory stores item configuration options associated with option prices (Abstract, Fig. 2, col. 5, lines 34-38, col. 7, lines 45-64 and col. 9, lines 30-33 – note the memory is the configuration database, the option prices are the MSRP and/or dealer invoice prices, and Cansler envisioned other products besides vehicles).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Kay to include the teachings of Cansler to allow for the memory to include at least one item configuration option associated with an option price, and to use this option price as the other price to associate with the digital content final price with the pricing formula. Doing so would allow for customers to choose and configure their own customized product in a more efficient and knowledgeable manner, for example by having pricing and compatibility information, as suggested by Cansler (col. 3, lines 58-65).

Referring to claim 2. Kay in view of Cansler discloses the digital content pricing apparatus of claim 1 wherein at least one of the plurality of digital content items is directly associated with the final pricing formula (Kay, Figs. 12C, 15 and 16 and pages 3-4, ¶¶0045-0052 – note the digital content is associated with a default price, a custom price and/or a discount which are directly associated with the final pricing formula).

Referring to claim 3. Kay in view of Cansler discloses the digital content pricing apparatus of claim 1 wherein the memory includes a plurality of pricing formulae including the

final pricing formula (Kay, Figs. 12C, 15 and 16 and pages 3-4, ¶¶0045-0052 – note that the memory is capable of storing one or many pricing formulae and that the difference between the memory containing a final pricing formula or a plurality of pricing formulae is only found in the nonfunctional descriptive material and would not distinguish the apparatus from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowrey*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959)).

Referring to claim 4. Kay in view of Cansler discloses the digital content pricing apparatus of claim 1 wherein at least one of the plurality of digital content items is associated with a plurality of configuration options, including the item configuration option (Cansler, Abstract, Fig. 2, col. 5, lines 34-38, col. 7, lines 45-64 and col. 9, lines 30-33) so that customers can choose and configure their own customized product in a more efficient and knowledgeable manner, for example, by having pricing and compatibility information.

Referring to claim 5. Kay in view of Cansler discloses the digital content pricing apparatus of claim 1 wherein the final pricing formula includes an option adjustment factor associated with the item configuration option (Kay, Figs. 12C, 15 and 16 and pages 3-4, ¶¶0045-0052 and Cansler, col. 7, lines 45-64) so that customers can choose and configure their own customized product in a more efficient and knowledgeable manner, for example, by having pricing and compatibility information.

Referring to claim 8. Kay discloses a digital content pricing system (see Abstract), comprising:

- a sales computer to calculate a final price (Fig. 1 and page 2, ¶0034 – note the computer is the billing system (160) that is capable of calculating a final price);;
- a purchase computer capable of being communicatively coupled with the sales computer (Fig. 1 and page 2, ¶0027 – note the purchase computer can be unit 105-1, 105-2 or 105-3 which can comprise of a computer terminal and/or a set-top box); and
- a memory capable of being communicatively coupled with the sales computer, including a plurality of digital content items (Fig. 1 and page 2, ¶¶0029-0032 and 0034 – note the memory is the server (130) which is capable of being coupled to the billing system), wherein each one of the plurality of digital content items is associated with a base price (Fig. 3 and page 3, ¶0045 – note the base price is the default price).

Kay discloses the memory storing a base price (i.e. the default price) and another price (i.e. a discount) wherein each of the plurality of digital content items is associated with a final price related to the base price and another price by a final pricing formula (Figs. 12C, 15 and 16 and pages 3-4, ¶¶0045-0052). However, Kay does not explicitly show wherein the memory includes at least one item configuration option associated with an option price, and wherein the other price associated with a final price to the digital content item by a pricing formula is the option price.

Cansler, in the same field of endeavor of electronic shopping, discloses a system for configuring a product using a server and computer network wherein the product has multiple configurations and the memory stores item configuration options associated with option prices

(Abstract, Fig. 2, col. 5, lines 34-38, col. 7, lines 45-64 and col. 9, lines 30-33 – note the memory is the configuration database, the option prices are the MSRP and/or dealer invoice prices, and Cansler envisioned other products besides vehicles).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Kay to include the teachings of Cansler to allow for the memory to include at least one item configuration option associated with an option price, and to use this option price as the other price to associate with the digital content final price with the pricing formula. Doing so would allow for customers to choose and configure their own customized product in a more efficient and knowledgeable manner, for example by having pricing and compatibility information, as suggested by Cansler (col. 3, lines 58-65).

Referring to claim 9. Kay in view of Cansler discloses the digital content pricing system of claim 8 further comprising an item selection device capable of being communicatively coupled to the purchase computer (Fig. 1 and page 2, ¶0027 – note the item selection device is the remote control unit (125) which is connected to the purchase computer).

Referring to claim 10. Kay in view of Cansler discloses the digital content pricing system of claim 9 wherein at least one of the plurality of digital content items is directly associated with the final pricing formula (Kay, Figs. 12C, 15 and 16 and pages 3-4, ¶¶0045-0052 – note the digital content is associated with a default price, a custom price and/or a discount which are directly associated with the final pricing formula).

Referring to claim 11. Kay in view of Cansler discloses the digital content pricing system of claim 10 wherein the final pricing formula includes an option adjustment factor associated with the item configuration option (Kay, Figs. 12C, 15 and 16 and pages 3-4, ¶¶0045-0052 and Cansler, col. 7, lines 45-64) so that customers can choose and configure their own customized product in a more efficient and knowledgeable manner, for example, by having pricing and compatibility information.

*Conclusion*

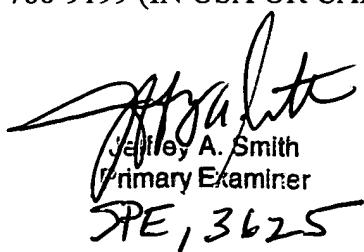
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

August 17, 2006

  
Jeffrey A. Smith  
Primary Examiner  
AAS, 3625